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EXAMINER

PIAZZA CORCORAN, GLADYS JOSEFINA

| ART UNIT | PAPER NUMBER |
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1733

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,817

Applicant(s)

SICOLA, PHILIP

Examiner

Gladys J Piazza Corcoran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 5-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of Species B in the reply filed on April 19, 2004 is acknowledged.
2. Claims 2 and 4 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species A and C, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 19, 2004.

Claim Objections

3. Claims 5 and 6 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The material worked upon does not add any patentable weight to apparatus claims (see MPEP §2115). It appears as if Applicant may intend the claims 1-7 to be method claims as currently written. If so, it is suggested to amend the claims to method claims..

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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6. Claim 8 is unclear in lines 14 and 15 by reciting "will be". It is unclear whether Applicant is positively reciting the limitations after will be or not. It is suggested to recite in the present tense --is adhered to the upper surface of the substrate and reflects--.

7. Claim 9 recites the limitation "the laminated substrate" in line 11. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend line 10 to recite, --allowing the glue to dry thus forming a laminated substrate--.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 5, 6, 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Hollman (US Patent No. 6,487,827).

As to claim 1, the material worked up in Apparatus claims are not given patentable weight (see MPEP §2115). Hollman discloses an apparatus capable of laminating three-dimensional surfaces comprising a means for forming three-dimensional features commencing at an upper surface and extending downwardly toward the lower surface of a substrate (soft former machine) and means capable of applying pressure to a top surface of a veneer to conform the veneer to the substrate (edge bander rollers).

As to claims 5 and 6, the material worked upon is not given patentable weight (see MPEP §2115).

As to claim 8, Hollman discloses a method for laminating three-dimensional surfaces by providing a substrate formed of a rigid material (strips of substrate) with an upper surface, a lower surface and a perimeter, forming three-dimensional features commencing at the upper surface and extending downwardly toward the lower surface (machining a pattern profile), providing a veneer (veneer), the veneer being formed of thin, resilient material and having a top surface and a bottom surface, applying glue to the bottom surface of the veneer the glue suitable for adhering the veneer to the substrate (applying glue to the veneer), positioning the veneer on the substrate, applying pressure to the top surface of the veneer to conform the veneer to the substrate and when the glue has dried, the veneer is adhered to the upper surface of the substrate and reflects the three-dimensional features of the substrate (column 5, lines 55-65).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hollman as applied to claim 1 above, and further in view of Loring (US Patent No. 4,628,976).

As to claim 3, Hollman discloses means for forming the three-dimensional features as a machine, however does not disclose the particulars of the machine. It is well known in the art to use powered rotary cutting and grinding tools for forming three-dimensional features. Loring discloses an example of a machine for forming three-dimensional features with powered rotary cutting and grinding tools. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the machine for forming the substrate as shown in Hollman with powered rotary cutting and grinding tools as is considered well known in the art in order to shape the substrate and as further exemplified by Loring.

12. Claims 1, 3, 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer-Schmutz (US Patent No. 2,252,040) in view of Hines (US Patent No. 5,669,744) and/or Inkster et al. (US Patent No. 4,850,407).

As to claim 1, the material worked up in Apparatus claims are not given patentable weight (see MPEP §2115). Fischer-Schmutz discloses an apparatus capable of laminating three-dimensional surfaces comprising a means capable of applying pressure to a top surface of a veneer to conform the veneer to the substrate (press A).

Fischer-Schmutz discloses a substrate with three-dimensional features commencing at an upper surface and extending downwardly toward the lower surface of a substrate (shaped wooden piece r), however does not specifically disclose the means for forming the three-dimensional features. Obviously, the substrate is formed in a curved shape, therefore there must have been some means for forming the shape.

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Furthermore, it is considered well known in the art of forming wood to provide means for forming wood with three-dimensional features. For example, both Hines and Inkster disclose means for forming three-dimensional features commencing at an upper surface and extending downwardly toward the lower surface of a substrate such as wood. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the apparatus in Fischer-Schmutz with a means for forming the shaped substrate as is considered well known in the art as further exemplified by Hines and/or Inkster.

As to claim 3, the means for forming the three dimensional features of a substrate in Hines and Inkster is a powered rotary cutting and grinding tool that is capable of being applied to the top surface of a substrate.

As to claims 5 and 6, the material worked upon is not given patentable weight (see MPEP §2115).

As to claim 7, the means for applying pressure in Fischer-Schmutz comprises an airtight, flexible container (press A) with a sealable opening sized and shaped to be capable to admit a substrate with a veneer disposed thereon (airtight mat on base plate i), and a means for evacuating the air from the container (escape holes and valve), and where the device is capable of providing atmospheric pressure to conform the veneer to an upper surface of a substrate.

As to claim 8, Fischer-Schmutz discloses a method for laminating three-dimensional surfaces by providing a substrate formed of a rigid material (shaped wooden piece r) with an upper surface, a lower surface and a perimeter, providing a

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veneer (veneer r1), the veneer being formed of thin, resilient material and having a top surface and a bottom surface, applying glue to the bottom surface of the veneer the glue suitable for adhering the veneer to the substrate (the veneer is glued to the substrate, therefore glue must be applied in some fashion to the bottom of the veneer), positioning the veneer on the substrate, applying pressure to the top surface of the veneer to conform the veneer to the substrate and when the glue has dried, the veneer is adhered to the upper surface of the substrate and reflects the three-dimensional features of the substrate.

Fischer-Schmutz discloses a substrate with three-dimensional features commencing at an upper surface and extending downwardly toward the lower surface of a substrate (shaped wooden piece r), however does not specifically disclose forming. Obviously, the substrate is formed in a curved shape, therefore at some point the three-dimensional features must have been formed. Furthermore, it is considered well known in the art of forming wood to provide substrates of wood by forming three-dimensional features on the substrate of wood. For example, both Hines and Inkster disclose it is known to form three-dimensional features on wood substrates. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of laminating three-dimensional surfaces in Fischer-Schmutz by forming the three-dimensional surfaces of wood substrate as is considered well known in the art and further exemplified by Hines and/or Inkster.

As to claim 9, Fischer-Schmutz discloses providing an airtight, flexible container (press A) having a sealable opening that is sized and shaped to admit the substrate with

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the veneer disposed thereon, inserting the substrate with the veneer disposed upon it into the flexible container, sealing the container, evacuating the air from the container, allowing the glue to dry and removing the laminated substrate from the container (page 1, lines 23-55).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gladys J Piazza Corcoran whose telephone number is (571) 272-1214. The examiner can normally be reached on M-F 8am-5:30pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gladys J. Piazza Corcoran
Examiner
Art Unit 1733

GJPC